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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 270

PERRY H. GENTZEL AND FOSTER ENGINEERING COMPANY,

Petitioner,

vs.

MANNING, MAXWELL & MOORE, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

I. Opinions Below.

The opinion of the United States Court of Appeals for the Second Circuit is reported, *Gentzel* v. *Manning, Maxwell & Moore*, 2 Cir., 230 F. 2d 341. The opinion of the district court is not reported but is annexed to the petition as Appendix B.

II. Jurisdiction.

The jurisdiction of this Court is invoked pursuant to the provisions of 28 USCA, Sec. 2101 and 35 USC, Sec. 281. The opinion and judgment of the Court of Appeals is dated March 1, 1956, a petition for rehearing was filed by the plaintiffs below, petitioners here and was denied on April 27, 1956, and the present petition was filed in this Court on June 21, 1956.

II. Questions Presented.

This is an ordinary action for alleged patent infringement. The Court below decided that the patent claims in suit were invalid for want of patentable invention, citing opinions of this Court. The other defenses were not passed upon, the Court saying "Since both patents are invalid so far as in issue before us, we do not reach the defendant's further contentions that the claims in the reissue patent 22,164 are unduly vague or that it did not infringe either patent" (p. 345). These were substantial defenses, and they would, we believe, have been sustained if the Court below had considered them.

There is no conflict between circuits. No other suit has been brought on the patents so far as the record shows or we know. The petition refers to "the absence of conflicting circuit decisions" (p. 36).

There is no question of public importance. The patents in suit, according to the petition and also the record (and as far as we know) have never been claimed by petitioners to have been used by any except the plaintiffs, petitioners here, and by defendant, respondent here. The petition states that "plaintiff and defendant are the sole competitors of the subject valve" (p. 33) and that "the petitioner is the only competitor of the respondent" (p. 35).

The complaint here of petitioners is that the Court of Appeals was wrong, and the trial court right, concerning whether the patent claims met the standards of patentable invention established by the patent statutes and court decisions. That is not sufficient reason for this Court to grant the petition and take the case, even if the Court of Appeals erred (it did not).

Keller v. *Adams-Campbell Company*, 264 U. S. 314, 319:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-

> infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

Magnum Import Co. v. *Coty*, 262 U. S. 159, 163:

> "The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes; first, to secure uniformity of decision between those courts in the nine circuits; and, second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

This Court does not "sit for the benefit of the particular litigants," *Rice* v. *Sioux City*, 349 U. S. 70, 74.

IV. Statement of Case and Argument

Petitioner (plaintiff) Gentzel is the patentee of the two patents, petitioner (plaintiff) Foster Engineering is his manufacturing licensee, and respondent (defendant) Manning is also a manufacturer.

The patents are "combination" patents, which should be scrutinized "with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements," *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, 152.

The controlling question concerning validity of the patents was essentially a matter of law, because it involved only a comparison of the patents in suit with the prior patents, there being no conflict in the evidence concerning their disclosures. The appellate court had the right to disagree with even the findings of fact by a trial court where "clearly erroneous". As stated by this Court in

United States v. *United States Gypsum*, 333 U. S. 364, 395, "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with a definite and firm conviction that a mistake has been committed". The Court below followed this decision in *Orvis* v. *Higgins*, 2 Cir., 180 F. 2d 537, saying that this Court "pointed out that a trial judge's finding does not have the dignity which jury verdicts derive from the Constitution nor the dignity which some statutes confer on findings of some administrative agencies" (p. 539).

The Court below was not required to accept the trial court's inferences and opinion concerning the patentability of the patent claims in issue.

A. Gentzel reissue patent 22,164.

This patent issued August 25, 1942, upon reissue application filed July 24, 1940, the original patent 2,145,870 issuing February 7, 1939 upon application filed January 30, 1935. All six claims are in suit.

The safety valve of this patent, and all the safety valves in the case, have a valve disk seated on the outlet nozzle from a boiler. Excess steam pressure will lift the valve disk from its seat, against a compression spring, and upon the pressure being reduced by escaping steam, the spring returns the disk to its seat.

There are many different types of such valves, as evidenced by the two patents in suit, the prior patents, and defendant's alleged infringing valves, no two being the same in all respects. Naturally, different operating conditions of boiler temperatures, pressures and capacities, costs of material, etc. require differences in engineering design, within the ordinary skill of the industry.

The Gentzel reissue patent relates to the way that the spring cross-rod is connected to the valve body, namely, by

frame rods. Prior to the Gentzel patent, two methods, frame rods and yokes, were employed, and are still employed, illustrated by defendant's Type 1419 valve and defendant's Type 1700 (Maxiflow) valve (plff's.' Ex. 16, pp. 12, 38).

In the Type 1419 valve, and in the old Crosby valves (plff's. Exs. 33, 34 and 35), the spring cross-rod is carried by two short rods resting on the top of the valve body, which is called a "yoke" type valve. The Gentzel reissue patent, and defendant's alleged infringing Maxiflow valves, use frame rods to carry the spring cross-rod, and the frame rods are anchored at or near the bottom of the valve body.

The frame rod type of valve was old, as shown by the prior patents of Paine 102,147, McCarty 944,809 and Jackson British 3,172. Accordingly, the patent claims are not broadly for use of frame rods, because that was old. Instead, the claims are narrow and limited to specific characteristics which the Court of Appeals found non-inventive. Claim 1 is typical:

> "1. A valve mechanism suitable for high temperature operation having *in combination** a valve casing provided with a fluid inlet port, a fluid outlet port, a valve seat between said ports,"

This is an ordinary valve.

> "and arms extended laterally from said valve casing near said fluid inlet port,"

The arms must be "near." Defendant does not have such "arms", but like Paine, McCarty and Jackson, anchors its frame rods on the valve casing.

> "a valve cooperating with said valve seat, a rod cooperating with said valve, a cross member located beyond said valve casing for supporting said rod,"

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*Emphasis added.

That is the ordinary valve.

> "supporting rods for said cross member connected with said laterally extended arms,"

The "supporting rods" are the frame rods, and old in Paine, McCarty and Jackson, which, like defendant, do not connect them to "arms".

> "said valve and valve seat being enclosed within said valve casing to prevent heated fluid from striking the supporting rods when the valve is open,"

This was old in McCarty and Jackson.

> "said supporting rods being spaced laterally a substantial distance from the valve casing."

The "substantial distance" is any distance such that the frame rods will not become too hot during operation. This depends upon the temperatures at which the valve is operated, the materials and sizes of the different valve parts, etc., etc., and is a matter of trial and error with any valve. This was also old, because inherent in any useful valve.

> "and of such length as to diminish the transfer of heat from the relatively hot part of the valve casing to said cross member, and thereby maintain relatively cool said cross member and the valve rod supported thereby".

The "length" is equally indefinite, adding nothing to existing knowledge that the frame rods should not be too short.

As grounds for this Court taking the case, the petition complains of the "Court of Appeals' Misconception and Misconstruction of Inventive Concept in Reissue Patent" (p. 9), and of the "Court of Appeals' Misconstruction of the Applicability of the Prior Art to the Reissue Patent" (p. 11.) But, even if there were misconceptions and misconstructions of patents in this case (there were not), the matter is not of public importance.

The petition says that the Court of Appeals erroneously "concluded that the basic conception of the Reissue patent is to prevent undesirable heating of the frame rods," and that this "basic conception" was instead "the *attachment* of the *lower ends* of the *frame rods* to the *casing below the valve seat*"* (p. 10). But that Court did not overlook this "attachment", its opinion (p. 343) referring to the Gentzel frame rods having the feature of "securing the bottom of the frame rods to the valve casing at its end nearest the boiler." The opinion also says "Thus plaintiff Gentzel's claimed invention consists of the positioning, place of attachment, and length of the frame rods"; and specifically refers to the frame rods attachment of the prior Paine, Jackson and McCarty patents.

As for the alleged misconception by the Court of Appeals of the prior art, the petition merely says that the Court below was wrong in its opinion that, in view of the various teachings of the prior patents, there was no patentable invention in the reissue patent's assembly of old elements. Obviously, this is a question of law, based on the respective patents, which that Court was at least as well qualified to decide as was the trial judge.

The Court of Appeals was right in holding that there was nothing worthy of a seventeen year patent monopoly in this description of what was at most only good engineering practice.

B. Gentzel patent 2,278,437.

Gentzel patent 2,278,437 issued April 7, 1942 on an application filed July 31, 1939. Eleven of its 17 claims are in issue.

When the valve disk lifts from its seat because of excessive steam pressure under the disk, the steam pressure

*Emphasis in petition.

immediately reduces because of escape to the atmosphere. The disk will return to its seat, forced by the compression spring, when the pressure is sufficiently reduced, this return being called "blowdown".

The primary outlet of the steam to the atmosphere is between the valve seat and the lifted valve disk. The amount and rate of the lift of the valve, and also its "blowdown", can be regulated by suitably proportioning the steam outlet passage from the boiler, ("jet" action), the size and shape of the valve disk and other contours externally adjoining the seat ("huddling" or "reaction" chamber). These features of valve design were old before this Gentzel patent, as it states (pat., p. 1, col. 1, l. 24 to col. 2, l. 20).

The alleged invention of this Gentzel patent is a specific construction of a secondary outlet for the steam, through exhaust holes to the atmosphere, the area of the holes being variable to control the amount of steam flowing through them. Such supplemental holes, for the same purpose, were old in the prior patents of Coale 459,268 and Houser 1,152,753, as pointed out by the Court of Appeals. The Gentzel structure differed, in having an exhaust belt (groove) into which the steam flows before passing through the exhaust holes, communicating with the groove, to atmosphere (defendant does not have an exhaust belt). The differences between the specific structures of Gentzel, Coale and Houser are, as correctly stated by the Court below (p. 345) "matters of engineering one, rather than invention", saying: "So we find this patent, like the other, to add at most only a slight refinement by rearrangement or repositioning of old elements to obtain a quicker or more uniform operation of the device. We do not see invention here."

The petition asserts that the Court of Appeals misconstrued the "Function of Valve of Patent 2,278,437" (p. 23), saying that "The Court of Appeals' evaluation of the function of the exhaust belt is inaccurate * * *" (p. 24).

But that Court correctly said that the exhaust belt was for "breaking down jet action and dispersing the steam so as to minimize blowdown" (p. 345), which is what the Gentzel patent itself states (p. 4, col. 1, ll. 30-43; p. 7, col. 1, ll. 8-20) and is what Gentzel testified (J.A. 95).

Incidentally, it may be observed that the petition is wrong in saying that the entry of steam into the exhaust belt with its holes open to the atmosphere "assists in raising the valve to its maximum opening or lift" (p. 25). The exhaust belt with its holes can only reduce the steam pressure which causes the lift.

The Court of Appeals was right in not finding patentable invention in this Gentzel patent.

C. The lengthy patent office prosecutions.

The petition (p. 30 et seq.) complains of the Court of Appeals reference (p. 345) to

> "the tortuous progress of these patents through the Patent Office from 1935 to 1942 and the many emendations of statement, especially in the second patent, made to meet the objections of examiners—a classic example of what Judge Learned Hand has called 'the ant-like persistency of solicitors' which overcomes 'the patience of examiners, and there is apparently always but one outcome.'"

The Court mentioned this "tortuous passage" only as "Of at least equal persuasiveness" to plaintiff's claim of commercial success, and the petition is wrong in saying "The Court's conclusion that a lengthy prosecution is necessarily persuasive of non-invention" (p. 31). The Court did not so conclude, and it was right, in the particular cases of the two patents in suit, in referring to the difficulties of obtaining allowance of any claims.

And the petition is also wrong in saying that "Lengthy prosecution in the Patent Office means simply that the Patent Examiner * * * had concluded that the subject matter

claimed was patentable over the references" and that "in his opinion as an expert the subject matter is clearly patentable" (p. 31). The law at the time of the prosecution of the Gentzel applications was, as then vigorously argued by Gentzel's patent attorney in the prosecution of the July 12, 1935 application, that "every reasonable doubt must be resolved in favor of an applicant" (file history, deft's. Ex. I, p. 71). This was stated in *In re Meyer*, CCPA, 123 F. 2d 1021, 1023 (1941) and *In re de Groote*, CCPA 127 F. 2d 322, 324 (1942), following *In re Thomson*, 26 App. D. C. 419, 425; 120 O. G. 2756 (1906):

> "In case of ordinary doubt, the policy of the patent system, as customarily maintained in the Patent Office, has been to give the applicant the benefit thereof, because no absolute right of property is conferred by the grant of a patent. (Ex. parte Fanshawe, C. D. 1891, 203). The patentee is merely put in a position to assert his *prima facie* right against infringers who may, in their defense, raise the question of the validity of the patent, and have the same finally adjudicated in the light of a full presentation and consideration of all the evidence attainable in respect of anticipation, prior knowledge, use, and the like."

In the present case, there is no evidence that the patent examiner or the patent office thought the claims were patentable, instead of being merely exhausted by the long and "tortuous" arguments referred to by the Court below, which apparently prevailed, because the patent was allowed.

Incidentally, the Court of Appeals was right in referring to the period from 1935 to 1942 for the prosecution of both patents, and the petition is wrong in suggesting (p. 30) that the prosecution of the second patent commenced only with the filing of a 1939 application. The patent itself states that its 1939 application is "a continuation in part of application Serial No. 31,011, filed July 12, 1935" (p. 10,

col 1, ll. 46, 47), and ten of the claims in the 1939 application as filed were taken verbatim from the 1935 application after having been strenuously prosecuted there (file history, deft's. Ex. J, p. 56). Patent claim 1 in suit was one of those claims, as were also, with slight modification, patent claims 2, 4 and 5 in suit.

D. The Court of Appeals was right concerning commercial success.

The petition (p. 32) relies, as in the Court below, upon commercial success, which that Court considered, declaring (p. 345) that "even a greater measure of success would not establish validity in the face of the clear showing here of anticipation by the prior art. *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, 567, affirming *Jungersen* v. *Baden*, 2 Cir., 166 F. 2d 807, 811."

CONCLUSION

This is an ordinary patent case, with no conflict of circuits, no error by the Court of Appeals complained of except misapplications of well established principles of law to specific facts, and of no general importance. Petitioners have failed to sustain their burden of establishing error in the Court below, and there was no error. The petition should be denied.

Respectfully submitted,

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